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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMEY GRAHAM, JONATHAN J. HULL,  
and DAVID G. STORK

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Appeal 2010-004555<sup>1</sup>  
Application 09/636,039  
Technology Center 2100

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Before LANCE LEONARD BARRY, JEAN R. HOMERE, and  
GREGORY J. GONSALVES, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is Ricoh Company, Ltd. (App. Br. 3.)

#### STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's non-final rejection of claims 11-19, 30-38, and 40-44. Claims 1-10, 20-29, and 39 have been canceled. (App. Br. 3.) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

#### *Appellants' Invention*

Appellants invented a method and system for annotating portions of a document that are relevant to a user-specified concept. (Spec. 2, ll. 14-17.) In particular, upon receiving from the user a keyword specifying a concept, a module searches the document to identify text patterns therein that are annotated and subsequently highlighted thereby visually emphasizing in a first display area portions of the document that are relevant to the concept entered by a user along with related text surrounding the locations of the entered keyword. Then, another module displays in a second display area a single thumbnail image displaying the annotated portions of the document whereby changes to the content of the document are dynamically reflected in the thumbnail image. (Spec. 2, ll. 19-34.)

#### *Illustrative Claim*

Independent claim 11 further illustrates the invention as follows:

11. A computer-implemented method of displaying a document using a browser, the method comprising:

accessing a document;

receiving user input of a selection of a first concept from a set of concepts;

displaying a section of the document in a first viewing area of a display including displaying annotations that visually emphasize portions of the document that are relevant to the first concept, the annotations visually highlighting portions of the document that include of one or more keywords associated with the one or more concepts and identified from a plurality of keywords stored for the first concept, wherein each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords;

extracting contents of the document, the contents comprising text and one or more elements;

displaying a single thumbnail image in a second viewing area of the display based on the content extracted from the document, the single thumbnail image displaying the contents of the document including the annotations in a continuous non-paginated form;

emphasizing an area of the single thumbnail image corresponding to the section of the document displayed in the first viewing area; and

dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document displayed in the first viewing area.

*Prior Art Relied Upon*

The Examiner relies on the following prior art as evidence of unpatentability:

Hart	US 5,546,502	Aug. 13, 1996
Nathan	US 6,326,957 B1	Dec. 4, 2001

Appeal 2010-004555  
Application 09/636,039

Nielsen	US 6,339,437 B1	Jan. 15, 2002
Okamoto	US 2002/0065814 A1	May 30, 2002

*Rejections on Appeal*

The Examiner rejects the claims on appeal as follows:

1. Claims 11-19, 30-38, and 40-44 stand rejected under 35 U.S.C. § 112, First Paragraph as failing to comply with the enablement requirement.
2. Claims 11-14, 17, 18, 30-36, 37, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Acrobat, Hart, and Nathan.
3. Claims 15, 19, 34, 38, and 41-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Acrobat, Nielson, Hart, and Nathan.
4. Claims 16 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Acrobat, Nielson, Hart, Nathan, and Okamoto.

**ANALYSIS**

We consider Appellants' arguments *seriatim* as they are presented in the principal Brief, pages 10-15.

*Enablement/Written Description Rejection*

**Dispositive Issue 1:** Have Appellants shown that the Examiner erred in concluding that the Specification does not enable the claim limitation of *visually emphasizing a keyword along with text related surrounding the location of the keyword*, as recited claim 11?

Appellants argue that the Specification at page 6, lines 18-25 provides adequate support for the cited limitation as follows:

relevant text may be bolded, underlined, a marginal annotation in the form of a rectangular bar may indicate a paragraph that has been determined to have relevance above a predetermined threshold...displaying information about a concept related to a phrase...may be used to annotate the document.

(App. Br. 10.)

Appellants further argue that visual emphasis can be achieved in ways that do not require modification of the related text itself (e.g., creating marginal annotation). (Reply Br. 5-6.)

In response, the Examiner concludes that the disclosure of merely placing a bar in the margin does not support the recitation of visually enhancing related text surrounding the keywords. (Ans. 13.)

We do not agree with the Examiner on this point. We note at the outset that while the cited rejection alludes to lack of enablement, the Examiner's statement of the rejection indicating that the Specification does not support the claim limitation seems to be directed to a lack of written description requirement instead. Consequently, we note that even though the cited portion of the Specification does not recite the disputed limitations *verbatim*, a *pro haec verba* test is not required to show support in the Specification. In our view, the ordinarily skilled artisan having read the Specification would have been apprised that annotating the margin of a paragraph can be used as a way to emphasize user-specified keywords and relevant text surrounding the keywords within the annotated paragraph.

Therefore, we conclude that the cited portion of the Specification adequately supports the claim recitation of annotations that visually emphasize text patterns and related text surrounding the locations of one or more user-provided keywords. It follows that Appellants have shown error in the Examiner's rejection of claim 11. Because the Examiner rejected claims 12-19, 30-38, and 40-44 for the same reasons set forth for claim 11, Appellants have also shown error in the rejection of those claims.

*Obviousness Rejection*

*Claims 11-14, 17, 18, 30-33, 36, 3,7 and 40*

**Dispositive Issue 2:** Have Appellants shown that the Examiner erred in finding that the combination of Acrobat, Hart, and Nathan teaches or suggests *dynamically changing the contents of a single thumbnail image to reflect a change in the contents of a document displayed in a first viewing area*, as recited claim 11?

Appellants argue that the Examiner erred in finding that proposed combination of references teaches or suggests the disputed limitations emphasized above. According to Appellants, Nathan's disclosure of merely updating the dynamic icon as the user writes on the digitizing tablet portion of a personal digital notepad does not teach dynamically changing the contents of a thumbnail image in response to a change in the content of the document. (App. Br. 11-12.) In response, the Examiner finds that Nathan's disclosure of dynamically maintaining thumbnail images to keep them current with the document that they represent teaches the disputed limitations. (Ans. 13-14.)

On the record before us, we agree with the Examiner's findings and ultimate conclusion of obviousness. In particular, Nathan discloses dynamically updating the thumbnail of a document as a user is continually updating the document to thereby reflect in the thumbnail changes made to the document. (Col. 6, ll. 15-18.) We find that because Nathan discloses dynamically updating the thumbnail to keep it current with the changes made in the document that it represents, Nathan fairly teaches or suggests the disputed limitations.

Further, we note that Appellants argue for the first time in the Reply Brief that the following point:

1. That the proffered combination does not teach or suggest displaying annotations that visually emphasize related text surrounding the locations of keywords. (Reply Br. 6-7.)
2. There is no rationale to combine Nathan and Acrobat as suggested by the Examiner. (*Id.* at 7.)
3. That neither Acrobat nor Nathan qualifies as valid prior art. (*Id.* 9-10.)

We find these new arguments untimely and unavailing.<sup>2</sup> Appellants are reminded that:

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<sup>2</sup> “[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in ... the principal brief[ ]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee.” *Kaufman Co. v. Lantech, Inc.*, 807 F.2d 970, 973 n.\* (Fed. Cir. 1986).

[T]he purpose of a reply brief is to ensure the Appellant the opportunity to have the last word on an issue raised by the Examiner. The reply brief enables the Appellant to address any new grounds of rejection the Examiner may have raised in the answer, or to address changes or developments in the law that may have occurred after the principal brief was filed. The reply brief is not an opportunity to make arguments that could have been made during prosecution, but were not. Nor is the reply brief an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.

Giving cognizance to belated arguments in a reply would vitiate the force of the requirement in Board Rule 37(c)(1)(vii) that “[a]ny arguments or authorities not included in the brief . . . will be refused consideration by the Board, unless good cause is shown.” The reference in that section to the “reply brief filed pursuant to § 41.41” does not create a right for the Appellant to raise an argument in the reply brief that could have been raised in the principal brief but was not. Rather, that reference merely puts Appellants on notice that arguments that could be made in the reply brief, but are not, are waived. ”

*See Ex Parte Borden IV*, Appeal 2008-004312, p. 4. (Jan. 7, 2010)

(informative.) It therefore follows that Appellants have not shown that the Examiner erred in finding that the combination of Acrobat, Hart and Nathan renders claim 11 unpatentable.

Because Appellants did not argue claims 12-14, 17, 18, 30-33, 36, 37, and 40 separately, they fall with claim 11 for the reasons set forth in our discussion above. *See* 37 C.F.R. § 1.37(c)(1)(vii).

*Claims 15, 19, 34, 38, and 41-43*<sup>3</sup>

Regarding claim 19, Appellants argue that the proposed combination of Acrobat, Nielson, Hart and Nathan does not teach or suggest displaying annotations that visually emphasize related text surrounding the locations of keywords. In particular, Appellants argue that while Nielson's disclosure of marking in a document keywords corresponding to query terms accepted from a user teaches emphasizing the keywords, it does not teach emphasizing related text surrounding the keywords. (App. Br. 13-14, Reply Br. 11.) In response, the Examiner finds that Hart (and not Nielson) was relied upon to teach the cited limitation. More particularly, the Examiner finds that Hart's disclosure of a system that emphasizes a concept and relevant text thereto in the course of a search for the concept teaches the disputed limitations. (Ans. 14-15.)

We find that Appellants have failed to persuasively rebut the Examiner's rejection. Despite the Examiner's attempt to bring to Appellants' attention that Hart (and not Nielson) was primarily relied upon for such limitation, Appellants continue to argue that the Examiner did not address the argument that Nielson does not teach the disputed limitations. Without getting into the merit of the rejection itself, we find that because Appellants failed to address the specific findings that the Examiner made in the Answer, Appellants have failed to show error in the Examiner's rejection of claim 19.

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<sup>3</sup> We note that this appeal does not contain a prior art rejection of dependent claim 44. Therefore, we do not review the merit of prior art rejections for possible application to claim 44.

Because Appellants did not argue claims 15, 34, 38, and 41-43 separately, they fall with claim 19 for the reasons set forth in our discussion above. *See* 37 C.F.R. § 1.37(c)(1)(vii).

*Claims 16 and 35*

Regarding claims 16 and 35, Appellants argue that the combination of Acrobat, Nielson, Hart, Nathan, and Okamoto does not teach or suggest modifying the style information for a first concept thereby changing the appearance of the document displayed in the first viewing area, as recited in claim 16. In particular, Appellants argue that Okamoto's disclosure of highlighting in a document keywords corresponding to search strings entered by a user does not teach the disputed limitations. (App. 14-15.) In response, the Examiner finds that proposed combination teaches the disputed limitations. (Ans. 15-16.)

We agree with the Examiner. As discussed above, Nathan discloses dynamically modifying a thumbnail to thereby keep it current with changes being made to the document it represents. Therefore, we find that one of ordinary skill in the art would have readily appreciated that upon modifying the style of the document, the thumbnail would be modified accordingly in order to keep current with the document. It follows that Appellants have not shown error in the rejection of claims 16 and 35.

Appeal 2010-004555  
Application 09/636,039

## DECISION

We reverse the Examiner's enablement/written description rejection of claims 11-19, 30-38, and 40-44. However, we affirm the Examiner's prior art rejections of claims 11-19, 30-38, and 40-43 as set forth above.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

pgc